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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/976,431 | 10/12/2001 | Louis B. Paludi | 1095_001CON | 1032 |

7590 09/09/2003

Robert E. Purcell, Esq.
Wall Marjama & Bilinski, LLP
Suite 400
101 South Salina Street
Syracuse, NY 13202

| EXAMINER | |
|---|---|
| ENATSKY, AARON L | |
| ART UNIT | PAPER NUMBER |
| 3713 | |

DATE MAILED: 09/09/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/976,431 | Applicant(s) PALUDI, LOUIS B. |
|---|---|---|
| | Examiner Aaron L Enatsky | Art Unit 3713 |

-- *The MAILING DATE of this communication appears on the cover she t with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *24 June 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Response to Notice of Appeal*

After giving consideration to arguments made by Applicant in the Appeal Brief of paper no. 10, Examiner has concluded that the finality should be withdrawn and prosecution reopened. A new non-final rejection follows below.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1- 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1, 11-12, and 22 Applicant uses the language "etc" and "substantially in a prescribed arrangement" to describe elements of a game structure. This language is permissible when one of ordinary skill in the art can determine the implied claimed limitations. However, the open-ended nature of this language in the instant claims does not allow one of ordinary skill in the art to determine the limitations.

Claims 1, 11-12, and 22 recites the limitation "the selected frames" or "the three selected frames" in last paragraph of the claims. There is insufficient antecedent basis for this limitation in the claim.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,319,123 ("the '123 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the application are merely broader than the patent claims. Once an applicant has received a patent for a species or a more specific embodiment, he is not entitled to a patent for the generic or broader invention. In the instant case, Applicant is claiming a library of images depicting events, which are used to determine winning conditions in a game machine. Whereas the '123 patent is depicting a specific embodiment of football, using football images to depict football events to create a winning game condition. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993)

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 6, 10-13, 15, 17, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,135,885 to Lermusiaux.

In regard to claims 1, 11-12, and 21-22, Lermusiaux teaches a video slot game machine containing a library of a plurality of non-identical images that illustrate situations occurring at different times during a sports event (2:7-46). The non-identical images of each series are represented in Lermusiaux as previous recorded movies of actual sports events/plays, wherein the movies of sports events require time sequenced non-identical images to represent the sport event (2:29-32 and 3:27-31). As the events are depicted as movies or animations, the images that together form a movie, are inherently one of a first time image, a second time image, and other time images sufficient to depict the sequential event. These images further constitute an array of frames meeting Applicant's requirement for frames arranged substantially in a prescribed arrangement. Movies and animations are made of images, where each image is located in a frame, which provides a sequential arrangement to correctly display the event. As noted above, this language provides no definitive limitations as to frame arrangement, thus can be interpreted broadly. Winning conditions are randomly selected, predefined events, selected from the different series of events by a processor (2:27-29) and then displayed for a user to view. Some

winning condition event examples are obtaining a first down, a touchdown, and a field goal (2:35-37).

In regard to claim 13, the frames are inherently adjacent to each other to provide a coherent movie/animation event.

In regard to claims 4, 6, 15 and 17, the events comprise a sports activity such as football (2:7-46) and can also be baseball (7:44-57).

In regard to claims 10 and 21, a player is awarded a prize for a winning condition (3:10-11).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-3, 5, 7-9, 14, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lermusiaux as applied to claims 1, 4, 6, 10-13, 15, 17, and 22 above, and further in view of US Patent No. 6,375,568 to Roffman et al. ("Roffman").

In regard to claims 2-3 and 14, Lermusiaux teaches the limitations as discussed above, but does not teach a specific arrangement of frames from left to right and in a matrix format, a second winning condition of a diagonal frame/image set, or a race game. Roffman teaches a video slot machine, with fewer or more than three reels in a matrix format (Fig. 3-3B). As is old and well known in the art, the reels comprise a series of identical and non-identical images

defining a library, where each turn on a slot machine produces a different event (8:19-44). Roffman also teaches an arrangement of a plurality of frames for displaying video images to define an event (Fig. 3A), the video slot machine game embodies various different sport themes of any type including football (7:57-67), and the video slot machines incorporate game features based upon associated theme (8:1-18). Lermusiaux and Roffman are related as slot gaming machines that utilize sports games to determine game outcomes and attract additional players that wish to wager on sporting events year round (Lermusiaux 1:50-63). One would be motivated to modify Lermusiaux to display the randomly chosen outcomes relating to sports games in a matrix format as taught by Roffman to allow for winning images events to be depicted in with real game images in a traditional slot game format rather then merely a text description of a game event as used in Roffman.

In regard to claims 7-8 and 18-19 and the provision of a second game stemming from a first game, Roffman discloses a first and second payout scheme which are directly linked to different winning conditions of different games (1:66-2:14).

In regard to claims 9 and 20 and the secondary winning condition comprising a football scoring play, Roffman teaches that if a player has scored a touchdown and no quarterback is assigned to the player's team, then the player becomes quarterback and a new game is then configured where the second winning condition differing from the initial winning condition lies in that a quarterback must be assigned to win the ensuing game/payout (12:19-26).

In regard to claims 5 and 16, Lermusiaux in view of Roffman teaches the claimed limitation as mentioned above, but does not specifically mention a game with an associated race activity. However Lermusiaux in view of Roffman does teach that a video slot game can

comprise any sport (Roffman 7:65-66). As Lermusiaux in view of Roffman teaches of a variety of sport games including the provision of any type of sport game, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the sport theme to include a race game.

***Response to Arguments***

Applicant has provided arguments that Examiner believes are not fully coterminous with current claims. Applicant arguments suggest that in the instant game there is a specific frame arrangement, wherein each displayed frame has an image from a library that is selected independently of the other frames, wherein a specific row of frame/image combinations make a complete time sequenced event for a winning condition. While this maybe Applicant's intention, the current claims provide no restriction as to frame arrangement, or the mechanism that distinguishes how an image is selected and displayed for each frame. Without this, the movie/animation events described in Lermusiaux are no different than Applicant's displayed time sequenced images. Furthermore, Applicant's winning condition only states that one of the events is established as a winning condition. If Examiner correctly ascertained Applicant's intention, the claim should clarify that a combination of the random separately chosen images, if forming a predefined event, establishes a winning condition.

The Examiner would also like Applicant to address the issue of how images commonly displayed on a video slot machine reels and their winning conditions are different from the instant invention. Video slot machines, as well known in the art, have a library of images that are used to form a representation of slot reels/frames. These predefined images are then referenced

against a set paytable in order to determine if a certain combination results in a winning combination. Almost any conceivable image can be used in the library of these video machines. Support of this ascertain can be easily found in a quick search of US Patent Classification 463 and 273. Winning conditions also have been shown for any number of combinations desired by slot machine developers, where the winning conditions are predefined sets of displayed images from the library, chosen solely by the desire of the developer. Examiner does not believe that Applicant's use of "time-sequenced" images to form a predefined set, creating a winning condition, is patentably different from commonly known predefined image sets. The instant invention appears to merely be substituting known images like fruits, with images of sports and referencing a sports sequence to a paytable to determine a winning in the same manner that the fruit would be referenced to the paytable. The fact that Applicant's images are "time sequenced" does not provide a non-obvious distinction as the requirement of time sequence is just a predefined set of images. The predefined images in the instant case are viewed by Examiner as one of a game designer's choice, and not one of a non-obvious improvement over previous slot machine games.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Aaron Enatsky
Sept. 04, 2003

Teresa Walberg
Supervisory Patent Examiner
Group 3700